

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: July 14, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re NexBank Capital, Inc.*  
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Serial No. 86394529  
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Jerry C. Harris, Jr. of Wick Phillips Gould & Martin, LLP,  
for NexBank Capital, Inc.

Anne M. Farrell, Trademark Examining Attorney, Law Office 118,  
Michael W. Baird, Managing Attorney.

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Before Cataldo, Wolfson, and Coggins,  
Administrative Trademark Judges.

Opinion by Coggins, Administrative Trademark Judge:

NexBank Capital, Inc. (“Applicant”) seeks registration on the Principal Register  
of the mark NEXBANK (in standard characters) for:

Financial affairs and monetary affairs, namely, financial information, management and analysis services; banking services; financial research; financial information; financial analysis; financial advice; financial planning; financial consultation; financial management; investment brokerage; investment consultation; investment management; investment advice; mutual fund investment; real estate lending; commercial lending for corporations; financial services, namely, management of treasury notes; loan servicing; securities deposit services; mortgage

banking; acquisition and merger consultation; corporate finance services, namely, consultation in the field of asset sales; in International Class 36.<sup>1</sup>

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as applied to the services identified in the application, so resembles the following marks owned by different entities:



-  for “banking services for young adults,” in International Class 36;<sup>2</sup> and
- NXT BANK (in standard characters, with “bank” disclaimed) for “banking services; and personal and commercial insurance brokerage,” in International Class 36;<sup>3</sup>

on the Principal Register as to be likely to cause confusion, to cause mistake, or to deceive.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration the appeal was resumed and eventually briefed.<sup>4</sup> The appeal was suspended when it came to the Board's attention that Registration No. 4380835, one of the registrations

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<sup>1</sup> Application Serial No. 86394529 filed on September 15, 2014, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant's claim of first use anywhere and use in commerce since at least as early as July 18, 2005.

<sup>2</sup> Registration No. 4380835, issued August 6, 2013.

<sup>3</sup> Registration No. 4978333, issued June 14, 2016.

<sup>4</sup> We presume the familiarity of Applicant and the Examining Attorney with the lengthy procedural history of this appeal.

which formed the basis for refusal under Section 2(d), was near the end of the grace period for a required Section 8 Declaration of Use and/or Excusable Nonuse. *See* 21 TTABVUE. Inasmuch as no Section 8 affidavit or declaration was filed, Registration No. 4380835 was ministerially cancelled on March 13, 2020. In view thereof, the appeal is resumed, and we now determine the Section 2(d) refusal only as to Registration No. 4978333 (NXT BANK), the remaining registration. As discussed below, we reverse the refusal to register.

### I. Evidentiary Issue

Before turning to the merits of the appeal, we address an evidentiary matter resulting from Applicant's attachment to its reply brief of a printout of a website (nxtplatform.org) that was not made of record during examination. 18 TTABVUE 10-14.<sup>5</sup> Applicant cites this exhibit in support of a new argument that the "term 'NXT' has a particular meaning in banking parlance." *Id.* at 6.

The new website evidence was not made of record during prosecution, and we exclude it because it is untimely.<sup>6</sup> Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). *See also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") Section 1203.02(e) (June 2020) and cases cited therein. We have given no consideration to this material or Applicant's related arguments in its reply brief. *See In re Luxuria,*

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<sup>5</sup> References to the briefs and other materials in the appeal record refer to the Board's TTABVUE docket system. Citations to the prosecution file refer to the USPTO's Trademark Status & Document Retrieval system ("TSDR") and identify documents by title, date, and page number of the downloadable .pdf version of the TSDR record.

<sup>6</sup> We act sua sponte because the evidence was attached to Applicant's reply brief, and the Examining Attorney thus had no opportunity to address it.

*s.r.o.*, 100 USPQ2d 1146, 1147-48 (TTAB 2011) (untimely materials attached to reply brief excluded and “because even a cursory review of the reply brief indicates that the brief discusses this material at length, applicant’s reply brief has not been considered”).

## II. Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) (“*DuPont*”). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. See, e.g., *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. See *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). When analyzing the factors, the overriding concerns are not only to prevent buyer confusion as to the source of the services, but also to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993).

A. The Services, Channels of Trade, and Classes of Consumers

We begin with the second and third *DuPont* factors. The second factor “considers [t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567), and the third factor “considers [t]he similarity or dissimilarity of established, likely-to-continue trade channels.” *Id.* at 1052 (quoting *DuPont*, 177 USPQ at 567).

The Examining Attorney points out that both Applicant’s and Registrant’s recitation of services includes, inter alia, “banking services.” 17 TTABVUE 5. We agree and accordingly find that the services are in part identical. Applicant does not argue otherwise.

Under the second *DuPont* factor, the Examining Attorney need not prove, and we need not find, similarity as to each activity listed in the identification of services. It is sufficient for a refusal based on likelihood of confusion that we find any activity that comes within the recitation of services in a particular class in the application related to any of the services within the cited registration. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015), *aff’d* 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (“[I]t is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a

particular class in the application.”). The second *DuPont* factor thus supports a finding of a likelihood of confusion.

Because the services identified in the application and the cited registration are in part identical, we presume that the channels of trade and classes of purchasers are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1745 (TTAB 2018), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019) (“Because the services described in the application and the cited registration are identical, we presume that the channels of trade and classes of purchasers are the same.”). The third *DuPont* factor thus also supports a finding of a likelihood of confusion.

#### B. Similarity or Dissimilarity of the Marks in Their Entireties

The first *DuPont* factor considers the “similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *In re Detroit Athletic Co.*, 128 USPQ2d at 1048. “The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong*, 127 USPQ2d at 1801 (quotation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016)

(citing *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)). Where, as discussed above, services are in part identical, “the degree of similarity necessary to support a conclusion of likely confusion declines.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012).

Applicant’s mark is NEXBANK, and the registered mark is NXT BANK with the generic word BANK disclaimed. The marks look and sound similar to the extent that each is comprised of an initial three-letter portion (i.e., NEX or NXT) followed by the generic word BANK. However, it is well settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations. *See Detroit Athletic*, 128 USPQ2d at 105 (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

There is nothing improper in stating that, for rational reasons, we give more or less weight to a particular feature of a mark, such as a common dominant element, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re Viterra Inc.*, 101 USPQ2d at 1908; *In re Nat’l Data Corp.*, 224 USPQ

at 751. Thus, we give greater weight to the distinctive NXT element of Registrant's mark. The significance of NXT, and its dominance, is reinforced not only by its being the only distinctive portion of Registrant's mark, but also by its location as the first part of the mark. *See, e.g., Detroit Athletic*, 128 USPQ2d at 1049. For similar reasons, we consider the NEX- element of Applicant's mark to be the dominant portion of NEXBANK.

Applicant argues that the NXT element of Registrant's mark and the NEX- element of its own mark "look[] and sound[] entirely different, providing distinctive commercial impressions." 12 TTABVUE 13. We agree.

The Examining Attorney's multi-step argument is that NXT is an abbreviation for "next," and the NEX- element of Applicant's mark sounds like the word "next." 17 TTABVUE 10. In support of this argument, the Examining Attorney points to a screen shot from acronymfinder.com showing that one meaning of NXT is "Next."<sup>7</sup> October 2, 2017 Office Action TSDR 9-10. Applicant argues that the Examining Attorney has not shown that NXT would be pronounced as "next," and it is more likely that NXT would be pronounced as three distinct letters: N, X, and T. 18 TTABVUE 6.

The acronymfinder.com screen shot does not indicate how NXT would be pronounced, and neither the sound of NXT as posited by the Examining Attorney nor its meaning as demonstrated by acronymfinder.com is corroborated by the record, for

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<sup>7</sup> The other meaning of NXT listed by acronymfinder.com is "NITE XML (Extensible Markup Language) Toolkit." October 2, 2017 Office Action TSDR 10.

example, by a dictionary definition, news article, or any other evidence to persuade us that consumers would pronounce NXT as “next” – as opposed to N-X-T – or understand NXT as meaning “next” when the NXT BANK mark appears in conjunction with Registrant’s banking and insurance services. The evidence of record does not support that NXT is itself a common English word, and it is well-established that “there is no correct pronunciation of a trademark.” *In re Viterra Inc.*, 101 USPQ2d at 1912; *see also In re Lebanese Arak Corp.*, 94 USPQ2d 1215, 1219 (TTAB 2010) (stating that “it has long been held that there is no correct pronunciation of a trademark that is not a recognized English word”). Although there is no “correct” way to verbalize the two NXT and NEX portions of the marks before us, we find a likely pronunciation of NXT in Registrant’s mark to be as three separate letters N-X-T, while NEX in Applicant’s mark is likely to be pronounced as “něks.” We find that the marks sound dissimilar to the extent NXT would be pronounced as three separate letters N-X-T.

Applicant argues that the NEX portion of its NEXBANK mark evokes “the idea of a nexus, that is, an intersection/integration of the different, but related services provided by Applicant under [its] mark.” 12 TTABVUE 14. While the Examining Attorney argues that Registrant’s mark NXT BANK conveys the commercial impression of “next bank,” 17 TTABVUE 10, she offers no evidence as to the commercial impression of Applicant’s mark. Similarly, the record contains no evidence that NEX has any meaning, and certainly no connotation when used in

connection with Applicant's financial services. Indeed, we can think of few words which begin with NEX-, but "next" and "nexus" are among them.

We find that while the marks have some similarities, they also have differences that affect their overall appearance, sound, connotation, and commercial impression when compared in their entireties as NXT BANK and NEXBANK. We find the Examining Attorney's multi-step approach to the similarity of the marks slightly too tenuous on the sparse record before us to convince us that confusion is likely, rather than merely possible.<sup>8</sup> The first *DuPont* factor weighs against a finding of a likelihood of confusion.

### C. Summary and Conclusion

While we find that the services are in part identical, and we presume that the channels of trade and classes of purchasers are the same, the dissimilarity in the overall connotation and commercial impression of the marks outweighs their similarities such that confusion is not likely. *See Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive."); *Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376, 119 USPQ2d 1286, 1290 (Fed. Cir. 2016) ("[A] single *DuPont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks") (quoting

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<sup>8</sup> We observe that the only evidence relating to sound, connotation, or commercial impression of either mark is the single page from acronymfinder.com, and on a different record, such as might be adduced in an inter partes opposition or cancellation proceeding, we might come to a different result on this factor.

*Odom's Tenn. Pride Sausage, Inc. v. FF Acquisition, LLC*, 600 F.3d 1343, 93 USPQ2d 2030, 2032 (Fed. Cir. 2010) (“[E]ven if all other relevant *DuPont* factors were considered in [opposer’s] favor, as the board stated, the dissimilarity of the marks was a sufficient basis to conclude that no confusion was likely.”)).

### III. Decision

The refusal to register Applicant’s mark NEXBANK is reversed.